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OFFICE OF PETITIONS

In re Application of :
Chang et al. :
Application No. 10/657383 : **ON PETITION**
Filed: 09/08/2003 :
Atty Dckt No. GLYO-P03-002 :

This is a decision in reference to the petitions filed on 25 May, 2007, which are treated as (a) a petition under 37 CFR 1.48(a)(1) requesting a person be deleted as a named inventor; (b) a petition under 37 CFR 1.47(a) and 37 CFR 1.183(a)(1) requesting waiver of 1.48(a)(1) in that a person sought to be added as a named inventor will not sign the statement of lack of deceptive intent or the declaration under 37 CFR 1.63 and 1.67; and (c) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.64 which requires that a named inventor execute a supplemental declaration.

The petition is **DISMISSED**.

Applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a), 1.183 and 1.48," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

On 8 September, 2003, the above-identified application was filed with a declaration naming Yan Chang and Vodek Sasak as joint inventors.

On 25 May, 2007, the present petitions were filed. Petitioners request that Vodek Sasak be deleted and David Platt be added as named inventors under 37 CFR 1.48(a)(1). Petitioners further request waiver under 37 CFR 1.183 of 1.48(a)(1) in as much as Platt refuses to sign the statement of lack of deceptive intent and the declaration under 37 CFR 1.63. A petition under 37 CFR

1.47(b) is requested in that the inventor sought to be added, as well as the existing inventor, refuse to the declaration under 37 CFR 1.63. Lastly, petitioners also request waiver under 37 CFR 1.183 of 1.64 in that a named inventor, Yan Chang, refuses to execute the supplemental declaration naming him as a joint inventor along with David Platt.

Petition Under 37 CFR 1.48(a) and Under 37 CFR 1.183 to Waive 1.48(a).

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;

(2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;

(3) the fee set forth in 37 CFR 1.17(i), and

(4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

With regard to the request to delete Vodek Sasak as a joint inventor, petitioners state that a copy of the statement of lack of deceptive intent was sent to Sasak, but that he has refused to sign and return it. A review of the official file reveals, however, that Sasak did in fact sign and return the statement, filing it with the USPTO on 30 April, 2007 (certificate of mailing date 26 April, 2007). As such, it is not necessary waive 1.48(a) under 37 CFR 1.183 with regard to inventor Sasak.

With regard to joint inventor David Platt, petitioners have shown that a letter was sent to Platt's attorney, asking for Platt's signature on the statement of lack of deceptive intent and on the declaration under 37 CFR 1.63 and 1.67, but that Platt's attorney Barry Schindler of the law firm Greenberg Traurig sent back a letter, dated 18 May, 2007, stating that Platt would not sign the statement of lack of deceptive intent or the declaration under 37 CFR 1.63 and 1.67.

Petitioners have also provided statements of consent of the assignee to the deletion of Vodak Sasak and the addition of David Platt as inventors.

The petition lacks item (2). As discussed *infra*, the decision has been held in abeyance pending submission of a declaration signed by an appropriate party on behalf of the inventors.

Petition Under 37 CFR 1.47(a).

With regard to David Platt's refusal to sign the declaration under 37 CFR 1.63 and 1.67, as joint inventors Sasak and Chang signed the original declaration filed on 8 September, 2003, at least one inventor (Yang) was available to sign the declaration. As such, a petition under 37 CFR 1.47(b) is not appropriate.¹ Rather, a petition under 37 CFR 1.47(a) is required with regard to Platt's refusal to sign the declaration under 37 CFR 1.63 and 1.67. Nevertheless, as no inventors are available to sign the declaration naming the actual inventors, an oath or declaration signed by an appropriate party on behalf of the non-signing and signing inventors is required.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (2). As no inventor is available to sign the declaration, although joint inventor Chang signed the original declaration, a declaration under 37 CFR 1.63, 1.64, and 1.67 signed by an appropriate party (*i.e.*, an officer of the corporation (president, vice president, secretary, treasurer, or chief executive officer)). The Officer must identify his or her title in the Declaration. If the Declaration is not signed by an officer of the corporation, then proof of authority of the person signing on behalf of the corporation must be submitted.

¹ Filing under 37 CFR 1.47(b) and 35 U.S.C. 118 is permitted only when no inventor is available to make application. MPEP 409.03(b).

Petition Under 37 CFR 1.183 to waive 1.64.

Petitioners lastly assert that inventor Yan Chang has refused to sign the declaration naming him and David Platt as joint inventors.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

There is no requirement for a showing under 37 CFR 1.47 with regard to joint inventor Chang, as noted above. This application bears an original Declaration executed by joint inventor Chang, and thus, the provisions of 37 CFR 1.47 do not apply with regard to Chang's signature. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

As stated above, an appropriate declaration signed on behalf of the inventors must be provided. The decision will be held in abeyance pending submission of said declaration.

Counsel's deposit account will be charged the fee for a petition under 37 CFR 1.47, as authorized in the present petition.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

A handwritten signature in dark ink, appearing to read "D Wood", is positioned above the typed name.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions